

REMARKS

Claims 1-25, 27-34, 36-44, and 46-48 are now pending in the present application. Claims 26, 35, and 45 have been canceled. Claims 1, 37 and 46 have been amended, and no claims have been added. Support for the amended claims is found in Table 4 of the present application. Those skilled in the art will understand granola cereal.

Applicant has carefully studied the outstanding Office Action. The present Response is intended to be fully responsive to all points of rejection raised by the Examiner and is believed to place the application in condition for allowance. Favorable reconsideration and allowance of this application are respectfully requested. No new matter has been added by any of the amendments to the specification. Applicant respectfully requests reconsideration and withdrawal of the Examiner's rejections in view of the foregoing amendments and following remarks.

CLAIM REJECTIONS – 35 U.S.C. §103(a)**Claims 1-25, 27-34, 36-38, and 46-48**

The Examiner rejected claims 1-25, 27-34, 36-38, and 46-48 under 35 U.S.C. §103(a), as being unpatentable over Calandro et al. (U.S. Patent No.5,093,146). The Examiner has stated that:

In absence of ingredients defining a granola dough, the dough of Calandro et al differs from the claimed dough only in name. The dough of Calandro et al contains dry ingredients, water and binder syrup which are the same components as the claimed dough. Calandro et al teach mixing the dry ingredients and then adding water and liquid sweetener; thus, it would have been obvious to one to first premix the water with the liquid sweetener before adding to the other ingredients to obtain a more uniform mixing. It would also have (been) obvious to one skilled in the art to determine the sequence of mixing which will give the most homogenous and uniform dough. This sequence can readily be determined through routine experimentation; applicant's has not shown any unexpected result or criticality with the claimed sequence of mixing. It would have been obvious to one skilled in the art to determine the temperature at which the binder syrup is maintained so that the syrup is workable. The addition of glycerin and sorbitol to control water activity and softening effect is well known in the art and would have been obvious to one skilled in the art.

Applicants believed that the ingredients defining a granola dough in the original application are known to those skilled in the art. It is not the role of the claims to teach one skilled in the art to reproduce the invention, but rather to define the legal metes and bounds of the invention. *In re Rainer*, 305 F.2d 505, 509, 134 U.S.P.Q. 343, 346 (C.C.P.A. 1962). However, in response to the Examiner's rejection, applicants have in good faith attempted to better define the dough of the components of the present invention. Applicants, however, do not disclaim any equivalents by these amendments to similar granola-type doughs. In light of the amendments made, Applicants respectfully request that the Examiner withdraw the rejections as to claims 1-25, 37-34, 36-38, and 46-48.

Further, all limitations of the claimed invention must be considered when determining patentability. *In re Lowry*, 32 F.3d 1579, 1582, 32 U.S.P.Q.2d 1031, 1034 (Fed. Cir. 1994). The Calandro reference is directed towards a cookie-like formulation. (See e.g., col. 3, lns. 28-30.) The present invention, on the other hand, is directed towards a granola dough requiring at least two dry ingredients selected from a rolled grain, crisp rice, and one or more inclusions for claims 1-25, 37-34, and 36-38. Further, claims 46-48 require the limitation of a cereal grain comprising at least one dry ingredient selected from crisp rice and rolled grains. Calandro fails to teach or suggest such a limitation. Consequently, the Applicants respectfully request that the Examiner withdraw the rejections as to claims 1-25, 27-34, 36-38, and 46-48.

Examiner further indicates,

It would have been obvious to use any type of extruder depending on the shape of the product being made. The making of shaped pieces using extrusion is well known in the art and it would have been within the skill of one in the art to determine the appropriate extrusion device.

As pointed out by Applicants in Paragraph 14 of the Published Patent Application, “. . . Granola is not susceptible to significant manipulation during production because its texture is easily destroyed. The dry grains of granola are susceptible to mechanical destruction and are generally not suited to extrusion or other similar processing.”

The initial burden of establishing a prima facie basis to deny patentability to a claimed invention is always upon the Patent Office. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). A prima facie case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). No prima facie case of obviousness has been established because the prior art fails to teach or suggest the use of an extruder for processing a granola dough. The rejection is believed overcome. Applicants respectfully request that the Examiner withdraw the rejections as to claims 1-25, 27-34, 36-38, and 46-48.

Examiner further states,

It would have been obvious to use roll extruder with varying dimension or die with varying compression ratio depending on the configuration of the product wanted.

Applicants, in paragraph 52 of the Published Patent Application specifically teach that, "... if the size of the extrusion port 52 is improperly selected relative to the size of the channel 44, the granola components are milled into smaller particle sizes and the texture of the final product is degraded as the granola is extruded." Conclusory statements of similarity or motivation, without any articulated rationale or evidentiary support, do not constitute sufficient factual findings. MPEP § 2144.08. As the Examiner failed to support his rejection of claims 13-17 with an explanation or specific citation to any reference, Examiner is respectfully invited to either withdraw the rejection of claims 13-17 or provide a specific citation to a reference disclosing the claimed invention. It is believed the rejection is overcome. Applicants respectfully request Examiner withdraw rejections as to claims 13-17.

Examiner further states,

... It would have been obvious to add filling to the pieces to obtain different flavor and taste. The type of filling selected is a matter of preference.

As pointed out by Applicants in Paragraph 14 of the Published Patent Application, "... the traditional apparatus for slabbing, compressing, and cutting granola ... does not enable

the use of a filling.” However, the Examiner simply states that addition of a filling to a granola product would have been obvious without providing any prior art to support such a statement. Calandro fails teach or suggest a filling that can be used in a granola dough.

Interestingly, this very point is supported by the Delpierre III reference which is directed towards a granola patent and cited by the Examiner. For example, Delpierre III indicates that, “The ingredients can be . . . agglomerated or compressed into bars or slabs which may be later cut to a desired size.” (Col. 1, Ins. 18-21). Further, Delpierre III teaches that, “[t]he mixture is baked or heated in a oven or drier to cook, brown and dry the product into a dry sheet of granola cereal which may be gently broken into bars or clusters and packaged.” (Col. 1, Ins. 52-56) (emphasis added). Delpierre III further teaches that the granola bed or slab can be “subdivided or broken after drying for sizing to the desired agglomerate or cut into granola bars.” (Col. 5, Ins. 20-22) (emphasis added). A reference may be said to “teach away” from the claimed invention when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant. *In re Gurley*, 27 F.3d 551, 553, 31 U.S.P.Q.2D 1130, 1131 (Fed. Cir. 1995). Not only does Delpierre III fail to suggest the desirability of an extruded granola, it teaches that the granola should be 1) gently 2) cut into bars 3) after a drying step. The present invention, on the other hand, claims 1) an extrusion step that 2) can cut the extruded granola into pieces 3) before a drying step. Thus, it would not have been obvious to add a filling to a granola dough as the Examiner contends.

The initial burden of establishing a prima facie basis to deny patentability to a claimed invention is always upon the Patent Office. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). A prima facie case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). Applicant traverses the assertion that “It would have been obvious to add filling to the [granola] pieces to obtain different flavor and taste,” and requests that Examiner cite a reference in support of his position as required by MPEP § 2144.03.

Claims 39-44

The Examiner rejected claims 39-44 under 35 U.S.C. §103(a), as being unpatentable over Calandro et al. (U.S. Patent No. 5,093,146) in view of Delpierre, III et al. (U.S. Patent No. 5,413,805). The Examiner has stated that:

Calandro et al do not disclose adding rolled oats and crisp rice coated with sugar.

Delpierre, III et al disclose rolled oat, crisp rice coated with sugar.

It would have been obvious to one skilled in the art to add the coated rolled oats and coat crisp rice as taught by Delpierre et al into the Calandro et al dough to obtain different texture, flavor and taste. The Calandro et al product is a breakfast cereal and it is notoriously well known in the art to add grain products such as oat and rice to cereal product. Delpierre et al do not disclose the amounts of sugar, crisp rice and oat. It would have been obvious to vary this amounts depending on the sweetness intensity wanted.

In determining obviousness, an applicant's teachings may not be read into the prior art. *Panduit Corp. v. Denison Mfg. Co.*, 810 F.2d 1561, 1575 n. 29, 1 U.S.P.Q. 1593, 1602 n. 29 (Fed. Cir. 1987) (citing need to "guard against hindsight and the temptation to read the inventor's teachings into the prior art"). A determination of the desirability of combining prior art references must be made without the benefit of hindsight afforded by an applicant's disclosure. *In re Paulsen*, 30 F.3d 1475, 1482, 31 U.S.P.Q. 1671, 1676 (Fed. Cir. 1994). The mere fact that the prior art could be readily modified to arrive at the claimed invention does not render the claimed invention obvious; the prior art must suggest the desirability of such a modification. *In re Ochiai*, 71 F.3d 1565, 1570, 37 U.S.P.Q.2d 1127, 1131 (Fed. Cir. 1996); *In re Gordon*, 733 F.2d 900, 903, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). Merely stating that the modification would have been obvious to one of ordinary skill without identifying an incentive or motivation for making the proposed modification is insufficient to establish a prima facie case. Examiner indicates that such motivation exists because grain products are commonly added to breakfast cereal. However, in determining whether particular references might be properly combined, whether it is obvious to try a combination is not a legitimate test. *In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1599 (Fed. Cir. 1988). The test is whether the combination of the references or modification would be obvious to do rather than obvious to try. *In re Deuel*, 51 F.3d 1552, 1559, 34 U.S.P.Q.2d 1210, 1216 (Fed. Cir. 1995). A general incentive does not make

obvious a particular result, nor does the mere existence of techniques which may be carried out to achieve the particular result. *Id.* A proper prima facie case of obviousness requires that the prior art reveal a reasonable expectation of success carrying out the proposed combination or modification. *In re Vaeck*, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991). Both the suggestion and the reasonable expectation of success must be found in the prior art, not in the applicant's disclosure. *Id.*

At best, the proposed motivation for combining the teachings of Calandro with Delpierre constitutes a statement of why the combination is obvious to try. Nothing in those references suggests a reasonable expectation of success. In fact, whereas Delpierre III is directed towards a “Low or No Fat Granola Cereal Mix,” (title) (emphasis added), Calandro is directed towards a “cookie-like formulation containing flour, fat or shortening, and sugar.” (Col. 3, lns. 28-30) (emphasis added).

Further, rather than teaching that a granola dough can be extruded, Delpierre teaches that the “mix can be ultimately subjected to a dehydration or baking operation with an optional forming operation, typically a 1 inch bed being compacted to, say, a $\frac{3}{4}$ inch bed and subdivided or broken after drying for sizing to the desired agglomerate or cut into granola bars.” (col. 5, lns. 17-22). It is unclear to the Applicant, how one skilled in the art looking at these two references would be suddenly motivated to add a resting step to enable a granola dough to be extruded.

The Examiner's failure to provide the necessary suggestion or motivation for the changes to Calandro, other than the aforementioned assertions, creates a presumption that the combination was selected by Examiner to support the obviousness rejection based on improper hindsight. A determination of the desirability of combining prior art references must be made without the benefit of hindsight afforded by the Applicant's disclosure. *In re Paulsen*, 30 F.3d 1475, 1482, 31 U.S.P.Q. 1671, 1676 (Fed. Cir. 1994). Thus, even if the Calandro and Delpierre III, et al references could be modified in the manner suggested by the Examiner, the modification or combination is not obvious, because such references fail to suggest or teach the desirability of the modifications. Thus, the claimed invention may only be reached using the presently claimed invention as a template to piece together and modify the teachings of the two reference patents to teach the presently claimed invention. Such reliance is an impermissible use of hindsight with

the benefit of Applicant's disclosure. Thus, it is respectfully submitted that the Examiner has not established a prima facie case of obviousness and the rejection of all claims should be withdrawn.

CONCLUSION

Applicant has adopted the Examiner's suggestions and believes the claims are in condition for allowance. It is respectfully urged that the subject application is patentable over references cited by Examiner and is now in condition for allowance. Applicant requests consideration of the application and allowance of the claims. If there are any outstanding issues that the Examiner feels may be resolved by way of a telephone conference, the Examiner is cordially invited to contact Chad Walter at 972.367.2001.

The Commissioner is hereby authorized to charge any additional payments that may be due for additional claims to Deposit Account 50-0392.

Respectfully submitted,

By: _____



Chad Walter
Registration No. 54,625
Attorney for Applicants

Date: October 5, 2005
CARSTENS & CAHOON, LLP
P.O. Box 802334
Dallas, TX 75380
(972) 367-2001 Telephone
(972) 367-2002 Facsimile